REMARKS

I. STATUS OF THE CLAIMS

Claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, and 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245, 247-253, 255-258, 260-266, 268-278, 280-290, 292-302, 304-307, and 309-311 are pending in this application.

II. INFORMATION DISCLOSURE STATEMENT

Applicants filed a Supplemental Information Disclosure Statement (IDS) on August 25, 2005. This Supplemental IDS was therefore timely filed before the Office Action mailed August 26, 2005. Accordingly, Applicants respectfully request that the Examiner consider the cited documents, and indicate that the cited documents have been considered by returning the signed and initialed Form PTO/SB/08. A copy of the stamped receipt postcard verifying the filing date and a copy of the Form PTO/SB/08 filed on August 25, 2005, is enclosed for the Examiner's convenience.

III. REJECTIONS UNDER 35 U.S.C. § 112

The Examiner rejected claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245, 247-253, 255-258, 260-266, 268-278, 290, 292-302, 304-307, and 309-311 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Office Action at 2.

The Examiner asserts that the language "at least one monomer chosen from" renders the claims vague and indefinite because a single, specific monomer is recited

and "there seem to be alternative limitations." Office Action at 2. Applicants respectfully disagree.

The phrase "chosen from" is not vague because it identifies possible monomers as those that follow the phrase. Even if a single monomer follows the phrase "chosen from," the claim is not vague because the language clearly sets forth the monomer that is claimed. Moreover, the claims use the term "comprises," which is used to leave the claim open to additional components. *See* M.P.E.P. § 2111.03. Therefore, the claims convey to one skilled in the art that the at least one (meth)acrylic copolymer comprises units derived from the recited monomers without excluding other monomers.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

IV. REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner rejected claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245, 247-253, 255-258, 260-266, 268-278, 280, 290, 292-302, 304-307, and 309-311 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,019,377 (*Torgerson et al.*) in view of U.S. Patent No. 6,013,722 (*Yang et al.*). Office Action at 3-6. Applicants respectfully traverse this rejection for at least the reasons set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the prior art. M.P.E.P. § 2143.01. Second, a reasonable expectation of success must exist in the modification of

the prior art. M.P.E.P. § 2143.02. Finally, the prior art must teach all of the elements recited in the claims. M.P.E.P. § 2143.03.

Applicants submit that the Examiner has failed to meet these basic criteria for at least the following reasons: (1) no motivation exists to substitute the copolymer of *Torgerson et al.* with the pressure sensitive adhesive of *Yang et al.*; (2) one skilled in the art would have little or no expectation of success in the substitution of the copolymer of *Torgerson et al.* with a pressure sensitive adhesive of *Yang et al.*; and (3) the combination of *Torgerson et al.* and *Yang et al.* fails to teach all of the elements recited in the present claims. *See* M.P.E.P. §§ 2143.01, 2143.02, and 2143.03

A. <u>There Exists No Motivation or Suggestion to Combine *Torgerson et al.* and *Yang et al.*</u>

1. *Torgerson et al.* and *Yang et al.* Provide No Motivation or Suggestion to Substitute the Adhesive of *Yang et al.* for the Copolymer of *Torgerson et al.*

The Examiner alleges that it would have been obvious to one skilled in the art to substitute the copolymer of *Torgerson et al.* with the an adhesive copolymer comprising n-butyl acrylate, 2-hydroxy ethyl (meth)acrylate and 2-ethyl hexyl acrylate monomers as "motivated" by *Yang et al.* because "1) Tongerson [sic] teaches using relatively hydrophobic acrylate copolymers to make shampoo and conditioners, wherein n-butyl acrylate and 2-ethyl hexyl acrylate are preferred [and] 2) Yang teaches that its adhesive copolymer imparts low haze thus clarity to the final products." Office Action at 6.

As an initial matter Applicants note that *Yang et al.* does not disclose a copolymer comprised of n-butyl acrylate, 2-hydroxy ethyl (meth)acrylate and 2-ethyl hexyl acrylate monomers as alleged by the Examiner. Applicants admit that the

presently claimed monomers are individually disclosed in different parts of *Yang et al.* However, *Yang et al.* never discloses the combination of monomers in the same composition. Moreover, neither *Yang et al.* nor *Torgerson et al.* suggest the use of the claimed combination of monomers.

The mere disclosure of individual elements in a single reference is not enough to establish obviousness; there must be motivation to combine those individual elements found in the prior art in the manner presented in the claims, otherwise the rejection is improper. M.P.E.P. § 2143.01. The Examiner has failed to identify any such motivation. Moreover, Applicants submit that the Examiner is improperly picking, choosing, and combining various disclosures within *Yang et al. In re Luvisi*, 144 U.S.P.Q. 646, 649-50 (C.C.P.A. 1965). "The examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). But for Applicants' disclosure, the Examiner has no basis to say that a person skilled in the art would select, for example, a copolymer comprising a combination of units derived from n-butyl acrylate, 2-hydroxy ethyl (meth)acrylate and 2-ethyl hexyl acrylate monomers. *See* M.P.E.P. § 2142 ("[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art").

Furthermore, *Torgerson et al.* discloses that at least one of the monomers is selected from acrylate amides or methacrylate amides to provide a single glass transition temperature ranging from about 0°C to about 80°C. *Torgerson et al.* at col. 3,

lines 20-30 and 46-56. Thus, the Examiner is alleging that it would have been obvious to one skilled in the art to use the claimed copolymer comprising n-butyl acrylate, 2-hydroxy ethyl (meth)acrylate and 2-ethyl hexyl acrylate monomers, which is not disclosed by *Yang et al.*, with the copolymer of *Torgerson et al.*, which must have a monomer selected from acrylate amides or methacrylate amides and have a single glass transition temperature ranging from 0°C to 80°C. Clearly, *Torgerson et al.* teaches away from such a combination because the combination alleged by the Examiner replaces elements required by *Torgerson et al.* *See* M.P.E.P. § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983) ("It is improper to combine references where the references teach away from their combination.").

2. *Torgerson et al.* and *Yang et al.* Provide No Motivation to Use the Claimed Weight Percents of the Monomers

Independent claims 167, 168, 171, 172, 174, and 175 recite at least one (meth)acrylate copolymer comprising:

> (a) from about 10 to about 90 weight percent of units derived from at least one monomer chosen from n-butyl acrylate monomers,
> (b) from about 2 to about 50 weight percent of units derived from at least one monomer chosen from 2-hydroxy ethyl (meth)acrylate monomers, and
> (c) up to about 80 weight percent of units derived from at least one monomer chosen from 2-ethyl hexyl acrylate monomers.

Independent claims 177, 178, 180, and 181 recite at least one (meth)acrylate copolymer comprising:

> (a) from about 10 to about 90 weight percent of units derived from at least one monomer chosen from n-butyl acrylate monomers,
> (b) from about 2 to about 50 weight percent of units derived from at least one monomer chosen from 2-hydroxy ethyl (meth)acrylate monomers, and

(c) up to about 80 weight percent of units derived from at least one monomer chosen from 2-ethyl hexyl acrylate monomers.

The Examiner alleges that "varying the weight ratio of the monomer [(i.e., n-butyl acrylate in claims 177, 178, 180, and 181)] would have been within the skill of the art [because g]enerally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indication such concentration or temperature is critical." Office Action at 5. The Examiner further asserts that "[i]t is viewed obvious to have found optimal or workable weight ratio of the monomers taught in Yang, particularly in view of Tongerson [sic], because Tongerson [sic] teaches that it requires a 'simple manipulation' to vary the weight ratio of the monomers during the synthesis of the copolymer to select appropriate solubility of the polymer." *Id.*

As explained above, neither *Torgerson et al.* nor *Yang et al.* specifically disclose a copolymer comprising units derived from n-butyl acrylate, 2-hydroxy ethyl (meth)acrylate and 2-ethyl hexyl acrylate monomers. Therefore, the references also fail to disclose the weight percent of each of those monomers as recited in the present claims.

Furthermore, the simple fact that the claimed invention is within the skill of one in the art "is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." M.P.E.P. § 2143.01 (citing *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993)). The Examiner has failed to provide an objective reason to combine the teachings of the reference. Instead, the Examiner relies on a statement in *Torgerson et al.* that "simple

manipulation" can be used to vary the weight ratio to select the appropriate solubility of the polymer. The Examiner, however, does not identify what an "appropriate solubility" is with respect to the alleged combination.

Applicants also submit that the "simple manipulation" is irrelevant to the Examiner's alleged combination because the "simple manipulation" refers to the copolymer of *Torgerson et al.* which must comprise a (meth)acrylate amide monomer. *See Torgerson et al.* at col. 3, lines 20-45. Thus, the Examiner has failed to show how one skilled in the art would arrive at a copolymer comprising units derived from n-butyl acrylate, 2-hydroxy ethyl (meth)acrylate and 2-ethyl hexyl acrylate monomers in the claimed amounts based on a teaching for a generic teaching regarding a copolymer comprising (meth)acrylate amide monomers.

B. No Reasonable Expectation of Success in the Combination of *Torgerson et al.* and *Yang et al.*

The Examiner alleged that it would have been obvious to one skilled in the art to have substituted the adhesive polymer of *Torgerson et al.* with the pressure sensitive adhesive of *Yang et al.*, and further, that "the skilled artisan would have had a reasonable expectation of successfully producing clear shampoos and conditioners with hair styling properties." Office Action at 5-6. The Examiner also alleges that *Yang et al.* teaches a pressure sensitive adhesive emulsion that is a cosmetically acceptable medium. *Id.* at 4.

Applicants respectfully disagree and submit that one skilled in the art would not have a reasonable expectation of success in the substitution of the copolymer of *Torgerson et al.* with the copolymer of *Yang et al.*, as alleged by the Examiner.

Torgerson et al. and *Yang et al.* are directed to two different inventions. *Yang et al.* discloses a pressure sensitive adhesive for use in "decorative, light management, and optical articles that require high clarity under a variety of conditions." *Yang et al.* at col. 3, lines 1-4. The pressure sensitive adhesive "must conform to strict optical requirements and be resistant to the effects of high humidity and heat." *Id.* at col. 3, lines 4-6. *Yang et al.* discloses uses for "tapes, labels, decals, transfer tapes and other articles." *Id.* at col. 7, lines 16-20. The pressure sensitive adhesive of *Yang et al.* comprises (a) n-butyl acrylate; (b) 2-hydroxy ethyl acrylate, 2-hydroxy ethyl methacrylate, or hydroxy propyl acrylate monomer; (c) optionally, co-polymerizable monomers; and (d) optionally, a multifunctional cross-linking agent that exhibits less than 2% increase in haze, less than 2% increase in opacity and greater than approximately 95% transmittance in the visible spectrum ranging from 380 to 720 nm after wet lamination process. *Id.* at col. 2, lines 21-32.

Torgerson et al., on the other hand, discloses a low glass transition temperature adhesive for use in hair styling products, such as mousses, shampoos, and conditioners, to provide styling hold. *Torgerson et al.* at col. 1, lines 12-20. The objective of *Torgerson et al.* includes good hair movement and good hair feel without making the hair feel stiff or sticky. *Id.* at col. 2, lines 27-51. To achieve these objectives, *Torgerson et al.* requires a copolymer having a single glass transition temperature ranging from 0°C to 80°C and comprising at least one monomer selected from acrylate amides or methacrylate amides.

Based on these teachings of *Torgerson et al.* and *Yang et al.*, a skilled artisan would have little reason to expect success in making the substitution alleged by the

Examiner. As an initial matter, *Yang et al.* does not teach that the pressure sensitive adhesive emulsion is a cosmetically acceptable medium despite the Examiner's assertions to the contrary. Thus, one skilled in the art would not expect the pressure sensitive adhesive of *Yang et al.*, which is designed for use as a laminate on a backing, such as tape or decals, to provide good hair feel without making the hair feel stiff or sticky when used in the composition of *Torgerson et al.* Moreover, *Torgerson et al.* requires a copolymer comprising at least one monomer selected from acrylate amides or methacrylate amides; monomers which are not required by *Yang et al.* Substituting a copolymer comprising units derived from n-butyl acrylate, 2-hydroxy ethyl (meth)acrylate and 2-ethyl hexyl acrylate monomers as allegedly taught by *Yang et al.* for the copolymer of *Torgerson et al.* would deprive the composition of *Torgerson et al.* of the required copolymer comprising a (meth)acrylate amide monomer.

Because the Examiner's alleged substitution fails to contain the monomers required by *Torgerson et al.*, one skilled in the art would not expect that the resulting copolymer would exhibit the traits desired by *Torgerson et al.*, or that it would successfully produce a clear shampoo or conditioner as alleged by the Examiner.

C. The Combination of *Torgerson et al.* and *Yang et al.* Does Not Teach All of the Claim Elements

Each of the independent claims recites that the composition "provides a reshapable effect."

The Examiner alleges that "reshapable denotes a physical property of the claimed composition" and that "whether a composition imparts reshapable styling effect on hair depends on the active components that make up the composition." Office

Action at 6. The Examiner asserts that "[i]t would have been obvious to the skilled artisan that, the composition of the combined references, which comprise the surfactants of Engel and the adhesive polymer of Yang, provides a reshapable effect on the hair as claimed by applicants." *Id.* at 6.

As an initial matter, Applicants note that the Examiner has withdrawn the rejection of the claims over the combination of *Engel* and *Yang et al.* Furthermore, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness because the Examiner has provided no evidence that a reshapable styling effect is a physical property, or that the composition of the combined references provides a reshapable effect.

Based on the Examiner's assertion that "the composition of the combined references . . . provides a reshapable effect," it is apparent that the Examiner is basing this rejection on an inherency argument because the Examiner does not suggest any further modifications to the composition of the combination. The M.P.E.P. states that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. § 2112 (citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

The Examiner has failed to provide any evidence to support the assertion that any composition resulting from a combination of *Torgerson et al.* and *Yang et al.* would provide a reshapable effect. Neither *Torgerson et al.* nor *Yang et al.* disclose a reshapable effect.

The pressure sensitive adhesives of *Yang et al.* are disclosed for use in tapes, labels, and other similar articles. *Yang et al.* at col. 6, lines 29-52. *Yang et al.* is silent as to a reshapable effect in a hair styling composition.

Torgerson et al. discloses a hair styling composition, but the composition only provides style hold. *Torgerson et al.* at col. 3, lines 9-13. Holding a hairstyle is not the same as providing a reshapable effect to the hair. *See* Specification at paragraph [026] ("Other terms, which may be synonymous with reshapable, include . . . restyleable."). The distinction between holding a hair style and providing a reshapable effect is known in the art. For example, WO 02/34218 (*Kantner et al.*), cited on the Information Disclosure Statement filed June 3, 2004, discloses a composition, including mousses, shampoos and conditioners, comprising a monomer derived from a (meth)acrylate monomers. *Kantner et al.* at paragraphs page 4, line 27 to page 6, line 29. *Kantner et al.* further teaches that the composition can be used as a hair styling agent, but the composition is **not** a reshapable hair styling composition, where *Kantner et al.* defines "reshapable hair styling compositions" as "a composition that can be restored or modified without new material or heat being applied." *Kantner et al.* at page 4, lines 15-23. Therefore, one skilled in the art would recognize that styling does not mean the same thing as reshapable.

V. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 27, 2006

By: 

Mark D. Sweet
Reg. No. 41,469

Enclosures: Copy of Form PTO/SB/08 filed August 25, 2005
Copy of Receipt Postcard dated August 25, 2005